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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,522	12/06/2001	Kan Ebisawa	450100-3580.2	3713
20999	7590	11/04/2003	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			JEANTY, ROMAIN	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,522

Applicant(s)

EBISAWA, KAN

Examiner

Romain Jeanty

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 53-283 is/are pending in the application.
- 4a) Of the above claim(s) 2-52, 144-283 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 53-143 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I claims 1, 53-143 in Paper No. 16 is acknowledged.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 68, 83, 99, 114 and 129 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the limitation of "within an original display" is not supported by the specification. The examiner is unable to find where such limitation is disclosed in the specification. Therefore, one skilled in the art would not know how to make and/or use the invention

Claims 53- 67, 84-98, 100- 113, 115-128 and 130-143 are necessarily rejected as being dependent upon the rejection of claim 1, 68, 83, 99, 114 and 129

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3. Claims 1, 62, 68, 83, 99, 114 and 129 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 68, 83, 99, 114 and 129 recites the limitation "said original display" in. It is unclear as to what original display applicant is referring. There is insufficient antecedent basis for this limitation in the claim.

Claims 62, 93 recite the limitation "said new advertisement data". It is unclear as to what new advertisement data applicant is referring. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, it is vague and indefinite as to what the "original display" means in the claim.

Claims 53-67, 84-98, 100- 113, 115-128 and 130-143 are necessarily rejected as being dependent upon the rejection of claim 1, 68, 83, 99, 114 and 129

In addition, claim 62, 93, 109, 124 and 139 recite the phrase "may be". It renders the claim indefinite because it is unclear whether the phrase is part of the claimed invention. Appropriate correction is needed.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 and 53-57,-59-60, 62-143 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (U.S. Patent No. 5,740,549) in view of Pirani et al (U.S. Patent No. 5,105,184).

As per claims 1 and 62, Reilly et al discloses an information and advertising distribution system comprising:

storage means for storing an executable program (i.e. database 134 for storing display script) (col. 5, lines 25-27; col. 9, lines 11-14);

receiving advertising data relating to at least one advertisement, and wherein said storage means store then received advertising data (col. 4, lines 29-36; col. 7, lines 14-17);

executing means for executing said executable program stored in said storage means and outputting display data incorporating the advertisement data stored in said storage means (col. 9, lines 12-17; col. 12, lines 57-61). Reilly does not explicitly disclose an original display data generated by said executable program. At best understood, Pirani et al, in the same field of endeavor, discloses the idea of displaying advertising software for displaying advertisement within an original display (col. 4, line 65 through col. 5 line 4; col. 6, lines 22-28). It would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify the advertisement system of Reilly et al to incorporate the original display function as evidenced by Pirani et al. A person having ordinary skill in the art would have been motivated to use such a modification in order to integrated and displaying advertisements.

As per claim 53, Reilly further discloses the apparatus of claim 1, wherein said means for receiving receives new advertising data each new day on which said

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executable program is executed (col. 9, lines 25-33).

As per claim 54, Reilly et al further discloses wherein said means Ear receiving receives new advertising data each time said executable program is executed (col. 9, lines 25-33).

As per claim 55, Reilly et al further discloses means for turning on said apparatus; and wherein said means for receiving receives new advertising data each time said apparatus is turned on (i.e., displaying advertisement the subscriber when the subscriber's computer is on) (col. 2, lines 28-34).

As per claim 56, Reilly et al further discloses wherein said means for receiving receives advertising data relating to a plurality of advertisements; and said program execution means outputs display data incorporating each of said plurality of advertisements at respective times within said original display data generated by said executable program (See rejection of claim 1).

As per claim 57, Reilly et al further discloses the apparatus of claim 1, wherein said means for receiving receives new advertisements data at predetermined time (col. 17, lines 14-17).

As per claim 59, Reilly et al further discloses wherein said means for receiving receives said executable program with said advertising data when said executable program is executed a first time; and said storage means is operable to store said executable program received by said means for receiving (see rejection of claim 1 above).

As per claim 60, Reilly further discloses wherein said means for receiving receives said executable program with said advertising data when said executable program is not

stored in said storage means and said storage means stores said executable program received by said means for receiving (See rejection of claim 1 above).

As per claim 63, Reilly et al and Pirani et al discloses means for receiving receives a plurality of advertising data corresponding to a plurality of executable programs; and said storage means stores the received advertising data corresponding to the executable a program to be executed by said program execution means (See rejection of claim 1).

As per claim 64, Reilly et al further discloses wherein said means for receiving receives said advertising data from a program transmitting system over a transmission line (See figure1) .

As per claim 65, Reilly et al does not explicitly disclose wherein said means for receiving receives said advertising data from a satellite transmission. Official Notice is taken that using satellite transmission is old and well-known technique that is used in the communication art to send receive and/or information. It would have been obvious to a person of ordinary skill in the art to use this well-known feature with the motivation of increasing the speed of transmission of the advertisement information.

As per claim 66, Reilly et al further discloses wherein said means for receiving receives said advertising data via a global computer network (i.e. by using the Internet and a computer network) (col. 4, lines 3-20).

As per claim 67, Reilly et al further discloses wherein said means for receiving receives said advertising data via the Internet (col. 4, lines 3-30).

Claims 68-72, 74-75, 77-88, 90-91, 93-103, 105-106, 108-118, 120-121, 123-133, 135-143 recite the same limitations as claims 1 and 53-57, 59-60, 62-143 above; therefore are rejected under the same rationale.

6. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (U.S. Patent No. 5,740,549) in view of Pirani et al (U.S. Patent No. 5,105,184) as applied to claim 1 and further in view of Handelman (U.S. Patent No. 5,539,450).

As per claim 58, Reilly et al discloses the predefined idleness criteria could be the failure to receive any input for a period of at least five minutes (col. 2, lines 28-34). However, Reilly et al and Pirani et al fails to explicitly disclose for inhibiting said program execution mean from executing said executable program when said means for receiving does not receive advertisement data at said predetermined times. However, Handelman teaches the idea of using an inhibiting means 100 that prohibits the execution of gaming activity in response to a control circuitry 22. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify the disclosures of Reilly et al and Pirani et al to incorporate the teachings of Handelman in order to facilitate the prevention of unwanted and/or unauthorized program execution.

Claims 73, 89, 104, 119 and 122 recite the same limitations as claim 58 above; therefore are rejected under the same rationale.

7. Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reilly et al (U.S. Patent No. 5,740,549) in view of Pirani et al (U.S. Patent No. 5,105,184) as applied to claim 1 and further in view of Hornbuckle (U.S. Patent No. 5,497,479).



As per claim 61, the combination of Reilly et al and Pirani et al does not explicitly disclose means for transmitting to a program service provider a program identification code identifying the executable program to be executed, and wherein said means for receiving receives from the program service provider advertising data corresponding to the executable program identified by said program identification code. However, Hornbuckle discloses the idea of transmitting an encoded package identification code when a software is downloaded from a host or central computer and the identification code identifies the program to be executed (col. 4, lines 4-5 and 18-23). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to the advertisement systems of Reilly et al and Pirani et al with inhibiting and transmitting means of as evidenced by Hornbuckle in order to facilitate the prevention of unwanted and/or unauthorized execution of the program.

Claims 76, 92, 107 and 134 recite the same limitations as claim 61 above; therefore are rejected under the same rationale.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm. If attempts to

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reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to: (703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,

Arlington VA, Seventh floor receptionist.

A handwritten signature in black ink, appearing to read "Romain Jeanty". The signature is fluid and cursive, with a long horizontal stroke extending to the left.

Romain Jeanty

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November 3, 2003